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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,448	03/05/2000	Moses M. David	55436USA6A	6966

32692 7590 07/15/2003

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EXAMINER

ALEXANDER, LYLE

ART UNIT PAPER NUMBER

1743

DATE MAILED: 07/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/519,448

Applicant(s)

DAVID et al. 

Examiner

LYLE A ALEXANDER

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-15, 17-25 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-15, 17-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11,13-15,17-25 and 27-30 are rejected under 35 U.S.C. 102(b,b,e,e) as being clearly anticipated by WO 98/33948, WO 98/59089, Dorfman et al. (USP 5,352,493 cited 4/30/03 by Applicants) or Neerinck et al.

See the appropriate paragraph of paper 17.

Dorfman et al. teach a method of forming a diamond like nanocomposite film on a substrate. Column 3 lines 50 through column 4 teach the film exceeds 40 atomic percent carbon and may not contain hydrogen. The content on silicon and oxygen is also taught.

Response to Arguments

Applicants' arguments filed 4/30/03 have been fully considered but they are not persuasive.

Applicants' state WO 98/33948 and Neerinck et al. fail to teach the claimed invention. Applicants state the specification teaches interpenetrating diamond like films referred to as DYLYN that may have significantly different properties than the films taught by the prior art. These remarks are not commensurate in scope with the pending claims that only require the characteristics taught by the prior art.

Applicants state WO 98/59089 discloses a non-sticking diamond like nanocomposite composition. Again, Applicants state the specification teaches

interpenetrating diamond like films referred to as DYLYN that may have significantly different properties than the films taught by the prior art. These remarks are not commensurate in scope with the pending claims that only require the characteristics taught by the prior art.

Applicants have made amendment to the non-elected claims 26 and 31-32 and requested rejoinder. The restriction requirement of paper 7 was made final in paper 11. Paper 15 stated new claims 31-32 were directed to an invention that is independent and distinct and has been restricted for the same reasons in paper 7. The amendments to claims 26 and 31-32 have not been considered because these claims are no longer pending and the restriction requirement has been made final. If Applicants submitted new claims capturing the original subject matter and the amendments to claims 25 and 31-32, the Office would maintain the restriction requirement based upon process of making and the product made.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYLE A ALEXANDER whose telephone number is 703-308-3893. The examiner can normally be reached on
MONDAY,WEDNESDAY,FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JILL WARDEN can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-3330 for regular communications and 703-872-3331 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



LYLE A ALEXANDER
Primary Examiner
Art Unit 1743

July 10, 2003